U.S. Patent Appln. No. 10/038,719
Amendment Dated July 21, 2005
Reply to Office Action of March 21, 2005
Docket No. BOC9-2000-0061 (196)

REMARKS/ARGUMENTS

These remarks are submitted responsive to the office action dated March 21, 2005 (Office Action). As this response is timely after the 3-month shortened statutory period, along with an appropriate fee.

In paragraph 2 of the Office Action, the Examiner has rejected claims 18-37 under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. In response, Applicants have amended claim 18 to clarify that the instant message is included within a computer readable medium. Applicants have amended claims 20 and 28 to clarify that the invention is for a computer program included within a computer readable medium. Dependent claims have been amended for consistency. Claim 37 has been amended to clarify that the instant messaging client is stored upon a computer readable medium. These amendments are fully supported by the specification. Applicants respectfully request that the § 101 rejections to claims 18-37 be withdrawn.

In paragraphs 3-7 of the Office Action, the Examiner has rejected claims 1, 3, 4, 20, 22 and 23 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,175,619 to DeSimone (DeSimone). In paragraphs 8-13 of the Office Action, claims 6-13, 16, 18-19, 25-32, 35 and 37 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over DeSimone in view of U.S. Patent Number 6,757,365 to Bogard (Bogard). In paragraphs 14-16 of the Office Action, claims 2, 5, 21 and 24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over DeSimone in view of U.S. Patent No. 6,650,747 to Bala, et al. (Bala). In paragraphs 17-19 of the Office Action, the Examiner has rejected claims 15, 16, 33-34 and 35 under 35 U.S.C. § 103(a) as being unpatentable over DeSimone in view of Bogard and in further view of Bala.

Lastly, the Examiner has provisionally rejected claims 1-37 under the judicially created doctrine of non-statutory double patenting over co-pending Application No.

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09/910,271 to Creamer, *et al.* (Creamer A); co-pending Application No. 09/910,270 to Creamer, *et al.* (Creamer B); and co-pending Application No. 09/910,187 to Creamer, *et al.* (Creamer C). An appropriate Terminal Disclaimer has been prepared and is filed together with the instant response to Office Action. Removal of the provisional Double Patenting rejection based on Creamer A, B, and C is herewith requested.

I. Claim Amendments

Claims 1-3, 6, 8-9, 12, and 18-37 have been amended to emphasize and clarify various disclosed aspects of the present invention. Specifically, claims 1, 9, 20, and 28 have been amended to clarify that a text or graphic symbol (an icon is defined as a suitable text or graphic symbol at page 9, lines 1-2) is displayed within a recipients IM interface. The symbol can be selected by a user (page 9, lines 12-14). The symbol can be displayed responsive to being first detected within the IM (page 8, lines 24-26). Selecting the symbol can cause a software program to be executed that automatically establishes a voice communication link (page 10, lines 10-13). Dependent claims have been amended for consistency.

Additionally, Claim 18 has been amended to clarify that the IM can include an attachment portion, as supported by page 10, lines 4-6. Claim 37 has been amended to clarify that the voice connection occurs over a telephony based voice communication link (page 7, lines 14-16).

No new matter has been added.

II. Applicants Invention as Claimed

Prior to addressing the rejections on the art, a brief review of the Applicants' invention is in order. Applicants teach a methodology for an IM communicator to convey voice communication information within an IM. A receiving IM application can

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detect this information and automatically display a conferencing icon. When a user selects the conferencing icon, a voice session is automatically established between the IM sender and the IM recipient.

III.   DeSimone fails to explicitly or inherently teach each claimed limitation

Claims 1, 3, 4, 20, 22 and 23 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,175,619 to DeSimone.

DeSimone assumes that two chat participant each have available telephone line for telephone communication. DeSimone teaches that a call initiator can reserve a telephone number associated with a telephone conference time using a Web interface. The reservation is performed by a Call Broker application. The Call Broker application establishes a conference time and conveys conference information to the initiator along with an access code (PAC). The initiator can then forward the conference information to one or more desired conference participants, such as forwarding as a text message during an instant messaging or private chat session. The call initiator and each of the call participants can contact the Call Broker at the established time, provide an identifier and a PAC associated with the reserved conference, which was contained in the conference information previously received, and can thereafter participate in a conference.

DeSimone basically teaches that conference reservations can occur between a web user and a software program, and that information regarding the conference reservations can be conveyed between potential conference participants using instant messages or other electronic notes. Conference calls are established at a later time when conferencing parties contact the conference broker using telephony equipment in a conventional manner.

DeSimone fails to teach that a recipient client detects a voice conference identifier within an IM. Desimone fails to teach that an IM interface of the recipient displays user

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selectable text or graphic. Desimone fails to teach that when a user selects a displayed text and/or graphic that a voice communication link is automatically established.

Since each claimed limitation is not explicitly or inherently taught by DiSimone, the rejections to claims 1, 3, 4, 20, 22 and 23 should be withdrawn, which action is respectfully requested.

III. Bogard Fails to Cure the Deficiencies of DeSimone

Claims 6-13, 16, 18-19, 25-32, 35 and 37 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over DeSimone in view of Bogard.

Bogard teaches a voice portal that allows a telephone user to send text messages to an instant message user. The voice portal can convert speech and DTMF input from a telephone user into a text message. The text message can be presented to an IM user. The IM user can type text messages in response, which can be provided to the voice portal. The voice portal can text-to-speech convert the text messages and audibly present them to the telephone user.

First, Bogard's purpose is to permit IM communications from a telephone interface using a voice portal. From MPEP 2143.01 it is improper to modify a reference in a manner that renders the reference unsatisfactory for its intended purposes. Any attempt to modify Bogard to require communications occur through IM interfaces and to initiate conferences only after information is conveyed through an IM interface, negates the purpose of Bogard. Thus, it is improper to combine Desimone and Bogard in the manner suggested.

Next, Desimone's purpose is to establish voice conferences using a Broker. The conferences are to occur at a designated time, not responsive to a user clicking an icon. Additionally, the conference establishment requires a positive act of contacting the Broker by both the sender of the conference information and the receiver of the

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information. Either can avoid the conference by failure to contact the Broker. This conflicts with the Applicants claimed teachings where a conferences is automatically and immediately established responsive to a unilateral action taken by the receiver. Modifications of Desimone to automatically, unilaterally, and immediate establish a conference would alter the principle of operation of Desimone, which is not permitted by MPEP 2143.01.

Even if it were not improper to combine the references of Desimone and Bogard, Bogard fails to cure the deficiencies of Desimone.

Referring to claims 1, 9, 20, 28, and 37 Bogard fails to that a recipient client detects a voice conference identifier within an instant message. Instead, Bogard teaches that a IM interface includes a VOIP feature. This VOIP feature is not activated by an IM, but is a separate function that is independent of any received or sent messages. Similarly, Bogard does not teach that a symbol or icon is displayed responsive to detecting a voice conference identifier.

Desimone even teaches away from having a selectable icon appear responsive to an IM, as the conferences reserved by Desimone occur at a designated time (not at the time of the IM) and require each participant to interface with a Broker. Allowing an IM receiver to directly establish contact, would contradict the teaching of Desimone that requires each participant to provide a participant identification code (PAC) to the Broker before a conference is permitted. It is not even possible for a sender to provide a PAC, assuming a conference is initiated unilaterally by an IM recipient, which is claimed.

Referring to claims 6, 7, 25, and 26 Applicants claim that selectable symbols are inserted into IM chat messages. Not only does Bogard fail to provide these teachings, but actually teach away from them, as the VOIP function of Bogard are implemented within application code and operate independent of IM messages. Attempts to change this

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principle of operation of Bogard to include activation symbols within IM messages alters the principle of operation of Bogard , which is not permitted by MPEP 2143.01).

Additionally, no conventional teachings are know or have been provided that teach selectable symbols are to be included within IM messages (so that a receipt can select the symbol and an action is to be taken). Instead, this novel practice used within the Applicants claimed invention contradicts conventional practices in the art.

Referring to claims 8, 9, 27, and 28 none of the cited references teach conveying a portion of user selectable code within an IM. Instead, the voice functions of Bogard require standard code written for an interface to be executed. Desimone fails to teach that programmatic code is to be conveyed at all, and instead teaches away from the practice of establishing a conference based upon code executed unilaterally by an information recipient.

Referring to claim 18, applicants claim that an attachment portion of an IM includes a voice conference identifier. Desimone provides conflicting teachings. Specifically, Desimone teaches that conference identifying information is to be contained within the message portion of an IM. These teachings are substantially different as the message portion is designed to be presented within the body of an IM interface, where the attachment portion is not. Hence, not only this limitation is not only not taught by a cited references, but conflicting teachings are explicitly provided.

Because each claimed limitation is not explicitly or implicitly taught by DiSimone, Bogard, or combinations thereof, the rejections to claims 6-13, 16, 18-19, 25-32, 35 and 37 should be withdrawn, which action is respectfully requested.

III. Bala Fails to Cure the Deficiencies of DeSimone and Bogard

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Claims 2, 5, 21 and 24 are rejected as being unpatentable over DeSimone in view of Bala. Claims 15, 16, 33-34 and 35 are rejected as being unpatentable over DeSimone in view of Bogard and in further view of Bala

Bala fails to teach that a recipient client detects a voice conference identifier within an IM. Bala fails to teach that an IM interface of the recipient displays user selectable text or graphic. Bala fails to teach that when a user selects a displayed text and/or graphic that a voice communication link is automatically established.

Because each claimed limitation is not explicitly or implicitly taught by DiSimone, Bogard, Bala, or combinations thereof, the rejections to claims 2, 5, 15, 16, 24, and 33-35 should be withdrawn, which action is respectfully requested.

Consequently, Applicants believe that this application is now in full condition for allowance, which action is respectfully requested. The Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

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